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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/691,392 | 10/17/2000 | Ronald A. Katz | PAT-009C | 3722 |
| 29129 7590 01/19/2007 MICHELLE A. ZARINELLI C/O WEST CORPORATION 11808 MIRACLE HILLS DR. MAIL STOP: W11-LEGAL OMAHA, NE 68154 | | | EXAMINER GORT, ELAINE L | |
| | | | ART UNIT 3627 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/19/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

| | | |
|-----------------|--------------|--|
| Application No. | Applicant(s) | |
| 09/691,392 | KATZ ET AL. | |
| Examiner | Art Unit | |
| Elaine Gort | 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-213 and 215-219 is/are pending in the application.
- 4a) Of the above claim(s) 24-35, 37, 38, 41, 51-67, 72-74 and 76-197 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23, 36, 39, 40, 42-50, 68-71, 75, 198-213 and 215-219 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date
:11/6/06;9/19/06;6/15/06;3/31/06;3/22/06;3/1/06.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 215 and 216 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 215 recites the limitation "claim 214" in line 1. There is insufficient antecedent basis for this limitation in the claim as claim 214 has been cancelled. Since application of prior art to the claims would require substantial speculation as to the scope of the claims by the examiner, no art rejection was applied. The lack of an art rejection should not be interpreted as an indication of allowability.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-23, 39, 40, 43-46, 50, 68-71, 75, 198-211, 217 and 218 rejected under 35 U.S.C. 102(e) as being anticipated by Fano (U.S. Patent 6,317,718).

Fano disclose a method for providing offers of a good, a service or information, utilizing an electronic communications device, between an offeror and a user of the electronic communication device (for example a PDA, see abstract), comprising the steps of:

Establishing communication via the electronic communications device between the offeror and user (for example communication is established between potential sellers and the user/buyer/shopper when it provides the user/buyer/shopper information about merchandise which the user/buyer/shopper has expressed interest in, see abstract);

Obtaining primary transaction data related to the primary transaction , the primary transaction data including user identity and user geographic descriptor data (for example username and password are disclosed in column 31 lines 1+ for providing identity data and a user's "persona locations" which relate to different contexts, such as work, home or vacation properties (cabin) disclosed for example in column 30 lines 22+. Examiner is construing the locations as geographic descriptor data);

Using the identity of the user to determine at least one additional data element (For example the rules related to items the user is interested in purchasing. Such as what type of airline ticket. If it is work related then certain rules apply, such as business or first class, but if personal then coach with non-refundable fares are preferred generally, see column 30 lines 22+):

Using the geographic descriptor of the user and the further data element to select among multiple items available for the geographic descriptor to determine an offer for a

Art Unit: 3627

good, service or information; and offering the item to the user (for example the user would be provided available flights that meet their specifications be it based on Home or Work);

(Regarding wireless and phone) where the device is a wireless phone (a PDA is a wireless phone, PDA disclosed in abstract);

(Regarding contact of user) where the offeror system contacts the user via the electronic communications device (for example see figures 26 and 27);

(Regarding negative decision criteria) Determination of an offer is subject to negative decision criteria (for example, the user does not have to purchase offers made via the system. The Persona also includes negative decision criteria, for example when all airline tickets other than United are eliminated relating to Work as the buyer wants United flights, see column 30 lines 60+);

(Regarding visual offer) where the offer is made visually to the user (see visual display in Figure 27);

(Regarding purchase item information, claim 68) Where the primary transaction data includes data representing a specific good, specific service or geographic descriptor of the user (For example, the item the user/buyer/shopper is interested in purchasing, for example, be it a good at a mall, an airline flight or a restaurant, see abstract, column 26 line 64+ and column 31 lines 22+); and

(Regarding data used to select item to present, claim 217) Where the geographic descriptor, further data element and the identity of the user is used to select among multiple items available (For example the system uses the user's ID, Persona,

Art Unit: 3627

and data relating to the good/service/information desired and also current location, to select among available items to only present items meeting the criteria based on this data. For example only provides airline ticket options that meet the required criteria based on this data, such as only presenting an airline ticket on United that is business class when the buyer is under the Work persona.).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Kolls (US Patent 6,389,337).

Fano discloses the claimed method but is silent regarding the offer comprising a coupon (claim 36), and the offer being made orally to the user (claim 42). Kolls teaches that it is known in the art of e-commerce to use a wireless phone (312) to offer a coupon (see Abstract line 13), where the offer is made orally to the user (via element 124) to provide an audible incentives for customers to accept the offers (for example customers that do not own PDA's but have cell phones). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of providing offers of Fano with the offering of coupons orally as taught by Kolls, in order to

Art Unit: 3627

provide an audible incentive for customers to accept offer. This is particularly advantageous for customers who have cell phones and not PDAs.

Claims 47-49, 212, 213, 215, 216, and 219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano.

As to claims 47-49, Fano shows all elements of the claims except the particular method of obtaining the geographic descriptor information. However, the examiner notes that the subject matter of claims 47-49 are obvious variants of the methods of obtaining the geographic descriptor data recited in claims 45 or 46. It would have been an obvious matter of design choice to use any of the methods recited in claims 47-49 since it is not disclosed that the particular method of obtaining the data solves any particular problem or is for a particular purpose, and it appears that the method would function equally well with either method.

It is noted that if it determined that the claimed subject matter is not merely an obvious variant, a species requirement would be necessary.

As to claims 47, 212, 213, 215, 216, and 219, Fano fails to show utilizing data representing the identify of the user (e.g., a phone number via ANI) to obtain data representing the geographic position of the user.

Malackowski et al. teaches the use of advertising system that sends advertisement to user via wireless telephone utilizing AN1 data to determine a geographic identifier of the user (see column 11, lines 39-44).

It would have been 'obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with wireless ANI data as taught by Malackowski et al, because utilizing a wireless phone extends the geopaphic range of communication between the user and the advertiser.

Regarding claims 48 and 49, Fano fails to expressly disclose a user or an operator manually entering geographic information.

The Examiner takes Official Notice that it was old and well known in the art at the time the invention was made to manually enter geographic identifying information by a user and an Operator.

It would have been obvious to one of ordinary skill in the art at the time the invention wms made to modify Fano with manually entered location data as is well known in the art, because manually entering the location reduces the operating expense of the advertiser to provide the hardware and software required to electronically determine the location of a user.

Response to Arguments

5. Applicant's arguments filed 5/22/26 have been fully considered but they are not persuasive. Applicant has not amended claims 215 and 216 and they continue to be indefinite. Applicant has argued that "Although the Examiner rejected independent claims 21, 68 and 217, no support from Fano was used to reject any element in the independent claims" and therefore Applicant believes them to be in condition for allowance. Examiner contends that Fano discloses the claimed invention and therefor

Art Unit: 3627

maintains the rejection. See details above regarding further explanation of the Fano reference used in the rejection.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

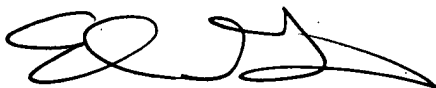
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571/272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Elaine Gort
Primary Examiner
Art Unit 3627

January 15, 2007